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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/873,505      | 06/04/2001  | Hongjie Cao          | 1928.PC             | 4692             |

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EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/873,505

**Applicant(s)**

CAO ET AL.

**Examiner**

Gina C. Yu

**Art Unit**

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 26-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

Receipt is acknowledged of response filed on June 8, 2004. Claims 26-48 are pending. Claim rejections made under 35 U.S.C. § 103(a) as indicated in the previous Office action dated March 21, 2004 are maintained for the reasons of record. Examiner notes that in the previous Office action claims 36-38 had been inadvertently omitted from the rejection statement that is made in view of Eskins et al. (US 5676994), Van Soest (US 6340527 B1), Fletcher et al. (US 6261543 B1), Goldember (SCC Seminar, Drug & Cosmetic Industry, 1996), and Macaulay (US 6362146 B1), and further in view of Ashley ("Sunburn and Sunscreen Preparations", Poucher's Perfumes, Cosmetics, and Soaps).

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 32-35, 39-42, and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eskins et al. (US 5676994) ("Eskins") in view of Van Soest (US 6340527 B1), Fletcher et al. (U.S. Pat. No. 6,261,543 B1) ("Fletcher"), and Goldemberg (SCC Seminar, Drug & Cosmetic Industry, 1996).

Rejection is maintained for the reasons of record.

2. Claims 26-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Eskins, Van Soest, Fletcher, and Goldemberg as applied to claims 32-35, 39-42, and 46-48 above, and further in view of Macaulay (US 6362146 B1).

Rejection is maintained for the reasons of record.

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3. Claims 29-31, 36-38, and 43-45 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Eskins, Soest, Fletcher, Goldemberg, and Macaulay as applied to claims 26-28, 39-42, and 46-48 above, and further in view of Ashley ("Sunburn and Sunscreen Preparations", Poucher's Perfumes, Cosmetics, and Soaps).

Rejection is maintained for the reasons of record.

### ***Response to Arguments***

Applicant's arguments filed June 8, 2004 have been fully considered but they are not persuasive.

Applicants' arguments are generally directed to the deficiencies of each reference. It is respectfully pointed out that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicants assert that the teachings of Eskins is limited to "unmodified starch". The reference in fact teaches, "modified starches may be used, however, to prepare the compositions of this invention, if certain properties are desired that are not obtainable with unmodified starches". See Eskins, col. 6, lines 31-41. Thus the emulsifier-free emulsion of Eskins also uses modified starches. The reference also states, "modified starch does not have the sticky, gummy properties of unmodified starch and also functions as an emulsion stabilizer". See Eskins col. 3, lines 55 – 65 (referring to the Hermansson patent).

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Thus it is well known in the art that emulsifier-free emulsion can be made with modified starch, as applicants have done in the present case.

The presence of surfactants in the Van Soest composition does not negate the teaching of the Eskins that modified starches stabilize emulsifier-free emulsion. While applicants argue that Van Soest invention is limited to using granula type of starch, examiner notes that the claims do not distinguish whether the starch is granular or non-granular. If the starch produced by jet cooking necessarily is non-granular type, it must be noted that the inventions in Claims 26, 28-47 do not require non-granular type of starches. Nowhere in the Van Soest indicates that granular type of starches is the only starch suitable for the invention. Furthermore, using modified starches produced by jet steam cooking is well known in the art, as evidenced by Eskins.

Applicants assert that Fletcher is not combinable with Eskins and Van Soest because former allegedly fails to teach aqueous formulation. The arguments are not persuasive as the Fletcher reference in fact teaches that the cationic modified starch is added in the aqueous phase of the emulsion to form a viscous emulsion. See abstract.

Applicants further argues that the prior art is limited to using hydrophilic active ingredients and that the prior art uses surfactants in the composition. Applicants make analogous arguments against applying Goldemberg. In response, examiner reiterates that it is Eskins which provides the teaching that modified starches can stabilize emulsion without the aid of emulsifiers.

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Encapsulating hydrophobic active compounds with modified starches is also taught by the primary reference.

While applicants assert that the rejection is a hindsight reconstruction made with numerous references, examiner respectfully points out that reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, all the evidences used to make the necessary motivation to combine references are taught in the references. Examiner asserts that no impermissible hindsight was used to make the rejections.

### ***Conclusion***

No claims are allowed.

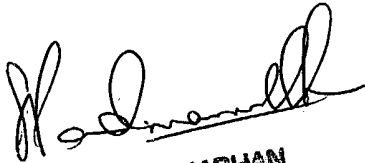
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu  
Patent Examiner



**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**